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09/520,810	03/08/2000	Noriyuki Fukuyama	F0540FT	2159

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EXAMINER

LY, ANH VU H

ART UNIT	PAPER NUMBER
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2662

DATE MAILED: 06/04/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

91

Office Action Summary

Application No.

09/520,810

Applicant(s)

FUKUYAMA ET AL.

Examiner

Anh-Vu H Ly

Art Unit

2662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-17, 25 and 27-37 is/are rejected.
- 7) ☒ Claim(s) 11, 18-24 and 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it included phraseology such as "first control means" in line 5 and "second control means" in lines 11-12. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objections

2. Claims 1 and 16-18 are objected to because of the following informalities:

Claim 1, line 9, examiner believes that "media terminal media" should be changed to "media terminal".

Claims 16-18, lines 3-4, examiner believes that "identification of a plurality of said communication terminals are stored in the terminal list of said communication terminal" should be changed to - "identification of a plurality of said communication terminals are stored in the control list of said information terminal" since as recited in claim 6, lines 6-8, that the information terminal includes a control target list having information identifying the communication terminals and wherein as recited in lines 14-16, that the communication terminal

Art Unit: 2662

having a terminal list identifying the information terminal. Therefore, the identification of communication terminals is stored in the control target list of the information terminal and the identification of information terminal is stored in the terminal list of the communication terminal.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6-27 and 34-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 6, the limitation recited in lines 12-13 “said one” lacks clear antecedent basis. It is unclear which one of the communication terminal out of at least one of the communication terminals being referred to. Further, as recited in line 14 “said communication terminal” lacks clear antecedent basis. It is unclear which communication terminal out of a plurality of communication terminals being referred to.

With respect to claim 12, the limitation recited in lines 6-7 “instructs data to be stored in said storage means, and the storage of said data” is confusing. It is unclear what is meant by “instructs data to be stored in said storage means, and the storage of said data”.

With respect to claim 26, the limitation recited in line 7 “the predetermined processing” lacks antecedent basis.

With respect to claim 27, the limitation recited in lines 3-4 “said information terminal of said communication terminal associates authentication information” is confusing. It is unclear

Art Unit: 2662

what is meant by “said information terminal of said communication terminal associates authentication information”.

With respect to claim 34, the limitation recited in lines 5-6 “reporting from said media terminal reports to said information terminal an instruction from a user” and in lines 12-14 “performing control from said information terminal of media communication function and/or media terminal function of information terminal” are confusing. It is unclear what is meant by “reporting from said media terminal reports to said information terminal an instruction from a user” and “performing control from said information terminal of media communication function and/or media terminal function of information terminal”.

With respect to claim 35, the limitation recited in lines 3-10 “a third control means that generates ... a control command wherein is recorded ... and send to the information terminal” is confusing. First of all, it is unclear the instruction from a user, as stated in line 4, applies to the input of the information terminal or the media terminal. Secondly, it is unclear a response or a control command is being generated by the third control means and sent back to the information terminal. And, at last, if a control command is being generated, it is unclear what is being reported back to the information terminal.

With respect to claim 36, the limitation recited in lines 7-8 “said information terminal” and in line 9 “the reporting” lack antecedent basis. Further, the limitation recited in lines 6-12 “generating ... a control command wherein the reporting ... is recorded” is confusing. First of all, it is unclear the instruction from a user, as stated in line 6, applies to the input of the information terminal or the media terminal. Secondly, it is unclear a response or a control command is being generated and sent back to the information terminal. And, at last, if a control

Art Unit: 2662

command is being generated, it is unclear what is being reported back to the information terminal.

With respect to claim 37, the limitation recited in lines 6-11 "receiving an instruction ... on packet switched network" is confusing. First of all, as stated in the preamble, a communication control program to be used in an information terminal, therefore, "a response to a control command from the information terminal" as recited in lines 6-7 is unclear.

Claims 7-27 are rejected because they depend on independent claim 6.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 28, 30, 32, 34, 36, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Shima (US Pub No. 2002/0004802).

With respect to claim 1, Shima discloses in Fig. 1, a functional configuration for implementing requested instructions from the information terminal 11 (information terminal) by the image information input-output unit 1 (a media terminal) through a data network (communication on a packet switched network). Such data network can be further illustrated in Figs. 3, 9, and 20, network 100 for connecting the information terminal and the image information input-output unit such as a scanner, a printer or a web server.

Shima discloses (page 2, 11th and 12th paragraph and Fig. 1) when retrieval information is entered from the outside of the image information input-output unit 1 (sending from the information terminal to the media terminal an instruction related to control of the media terminal on the packet switched network), the conversion means 5 look up in the management table 5 and converts the retrieval information into predetermined control information. For example, when a URL of <http://xxx/action/300 dpi/> is entered, if “action/300 dpi” is previously related to the control information meaning “read image at read resolution 300 dpi” in the management table 4, the URL is converted into control information by the conversion means 5, whereby the image read operation at 300 dpi is executed (controlling from the media terminal at least one of a communication function and a function of the media terminal on the packet switched network in accordance with the instruction from the information terminal).

With respect to claims 2-4, 34, 36, and 37, Shima discloses in Fig. 1, a functional configuration for implementing requested instructions from the information terminal 11 (information terminal) by the image information input-output unit 1 (a media terminal). Shima discloses (col. 1, 6th paragraph) image information input-output units have been often shared through various networks such as a LAN and an intranet (communication on a packet switched network).

Shima discloses in Fig. 1, the information terminal 11 (information terminal) comprising a read retrieval means 12 (a first control means) for generating retrieval information. Further Shima discloses (page 2, 12th paragraph) wherein retrieval information is used to indirectly specify control information, whereby predetermined image information input-output processing

Art Unit: 2662

is performed. Thus if the user uses an information terminal that can issue retrieval information for using the hypertext information retrieval environment 2 resided within the image information input-output unit 1 (information terminal includes a first control means that generates a control command based on an instruction from a user, the control command including an instruction related to control of media terminal, and information terminal being configured to send the instruction to the media terminal).

Shima discloses in Fig. 1, the image information input-output unit 1 (media terminal) comprising an information retrieval environment 2 for implementing the retrieval information sent by the information terminal 11 (a second control means for controls at least one of a media communication function and a media terminal function on the packet switched network, the control being based on the control command sent from information terminal).

With respect to claim 5, Shima discloses in Fig. 20, image information processing system comprising the information terminal 61 (information terminal), a management server 121, a plurality of scanners and printers (a plurality of communication terminals). Shima discloses (page 13, 219th – 224th paragraphs) an operation executed among the information terminal 61 (information terminal), the management server 121 (first communication terminal), and the scanner 121 (second communication terminal). When the information terminal 61 requests the web server section 123 of the management server 121 to transfer a general page WP21 (sending from information terminal to a first of communication terminals an instruction related to media communication on the packet switched network). If the user chooses a desired parameter out of a read resolution choice page, a URL indicating the parameter is sent to the management server

Art Unit: 2662

121. The URL interpretation section 126 of the management server 121 converts the received URL into a predetermined control command. The control command is transmitted to a predetermined scanner 131, which then interprets the control command, executes scan processing, and transfers an image file provided by scanning to the management server 121, which then transfers the image file received from the scanner 131 to the information terminal 61 (performing in first of communication terminal media a communication with a second of communication terminals on the packet switched network in accordance with the instruction from the information terminal).

With respect to claims 28, 30, and 32, Shima discloses (page 13, 219th – 224th paragraphs) when the information terminal 61 requests the web server section 123 of the management server 121 to transfer a general page WP21, the management server 121 returns the general page WP21 to the information terminal 61. The general page WP21 is a page indicating the business machines connected to the network 100 for each type, such as scanners and printers, as shown in Fig. 22 (a control target list wherein is stored information relating to a predetermined communication terminal also connected to the packet switched network). If the user chooses a desired parameter out of a read resolution choice page, a URL indicating the parameter is sent to the management server 121 (a first control means that generates, based on an instruction from the user, a control command that includes an instruction related to media communication and sends that control command to the predetermined communication terminal).

Art Unit: 2662

5. Claims 5, 29, 31, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Szlam (US Patent No. 6,359,892).

With respect to claim 5, Szlam discloses in Fig. 1, the portable communication device 10 (information terminal) connects to the outside party 12, main office 13, branch office 14, and other office 15 via the communication links 11. Further, as illustrated in Fig. 2B, a plurality of office equipments, resided within the main office 13, are, but not limited to, telephone sets 217A-C, computers 221A-C, corporate devices, equipment, resources and services 220, etc... (a plurality of communication terminals). Szlam discloses (col. 8, lines 32-40) the communication links may be the cellular telephone service, satellite link services, private carriers, the Internet via an ISP (packet switched network), two-way cable service, ATM lines, etc....

Szlam discloses (col. 9, lines 47-51) that the controller 225, as illustrated in Fig. 2B, can receive commands from the remote communication device 10 (sending from the information terminal to a first of communication terminals an instruction related to media communication on the packet switched network), converts these commands to CTI commands, and send the CTI commands to the appropriate device, such as the PBX 216 (performing in first of communication terminal media a communication with a second of communication terminals on the packet switched network in accordance with the instruction from the information terminal).

With respect to claims 29, 31, and 33, Szlam discloses (col. 20, lines 9-11) the user of the remote communication device 10 (information terminal) can store a user profile in the controller 225 (a communication terminal) which the controller 225 inspects whenever an incoming call for the user is received (a terminal list wherein is stored information relating to a predetermined

Art Unit: 2662

information terminal also connected to the packet switched network). Szlam discloses (col. 9, lines 47-51) that the controller 225, as illustrated in Fig. 2B, can receive commands from the remote communication device 10, converts these commands to CTI commands, and send the CTI commands to the appropriate device, such as the PBX 216 (a second control means that receives from predetermined information terminal a control command wherein is recorded an instruction related to media communication, and performs, based on the control command, media communication with another communication on the packet switched network).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-10, 12-17, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima (US Pub No. 2002/0004802) in view of Szlam (US Patent No. 6,359,892).

With respect to claims 6, 8, 12-17, 25, Shima discloses in Fig. 20, image information processing system comprising the information terminal 61 (information terminal), a management server 121, a plurality of scanners and printers (a plurality of communication terminals) on network 100 (communication on a packet switched network).

Shima discloses (page 13, 219th – 224th paragraphs) when the information terminal 61 requests the web server section 123 of the management server 121 to transfer a general page

Art Unit: 2662

WP21, the management server 121 returns the general page WP21 to the information terminal 61. The general page WP21 is a page indicating the business machines connected to the network 100 for each type, such as scanners and printers, as shown in Fig. 22 (a control target list having information identifying at least one of the communication terminals). Shima does not explicitly disclose the information terminal includes a control target list. Szlam discloses (col. 20, lines 9-11) a method of storing the user information of the remote communication device 10 in the controller 225. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the general page WP21 in the information terminal in Shima's system, as suggested by Szlam, in order to identify the connected machines in the network 100.

Shima discloses in Fig. 1, the information terminal 11 (information terminal) comprising a read retrieval means 12 (a first control means) for generating retrieval information. Further Shima discloses (page 2, 12th paragraph) wherein retrieval information is used to indirectly specify control information, whereby predetermined image information input-output processing is performed. Thus if the user uses an information terminal that can issue retrieval information for using the hypertext information retrieval environment 2 resided within the image information input-output unit 1 (information terminal includes a first control means adapted to generate, based on an instruction from a user, a control command that includes an instruction related to control of media terminal, and information terminal being configured to send the control command to one of communication terminals).

Shima does not disclose communication terminal includes a terminal list including information relating to the information terminal. Szlam discloses (col. 20, lines 9-11) the user of

Art Unit: 2662

the remote communication device 10 (information terminal) can store a user profile in the controller 225 (a communication terminal) which the controller 225 inspects whenever an incoming call for the user is received. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a method of storing user profile of the remote communication device (terminal list including information relating to the information terminal) in the controller 225 (communication terminal) in Shima's system, as suggested by Szlam, in order to authenticate and verifying the originated control commands.

Shima discloses (page 13, 219th – 224th paragraphs) that if the user chooses a desired parameter out of a read resolution choice page, a URL indicating the parameter is sent to the management server 121. The URL interpretation section 126 of the management server 121 converts the received URL into a predetermined control command. The control command is transmitted to a predetermined scanner 131, when then interprets the control command, executes scan processing, and transfers an image file provided by scanning to the management server 121, which then transfers the image file received from the scanner 131 to the information terminal 61 (a second control means for performing, based on the control command received from the information terminal, media communication with a second of communication terminals on the packet switched network).

With respect to claims 7 and 10, Shima discloses (page 13, 219th – 224th paragraphs) if the user chooses a desired parameter out of a read resolution choice page, a URL indicating the parameter is sent to the management server 121. The URL interpretation section 126 of the management server 121 converts the received URL into a predetermined control command. The

Art Unit: 2662

control command is transmitted to a predetermined scanner 131, when then interprets the control command, executes scan processing, and transfers an image file provided by scanning to the management server 121, which then transfers the image file received from the scanner 131 to the information terminal 61 (the second control means of the communication terminal further generates a control command that reports the state of communication with second of communication terminals on the packet switched network and sends that control command to the information terminal).

With respect to claim 9, Shima discloses in Fig. 1, a display unit 14 for displaying the control commands sent from the image information input-output unit (information terminal has an output means that outputs in accordance with the control command sent from the communication terminal).

Allowable Subject Matter

7. Claims 11, 18-24, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claim 27 and 35 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yablon (US Patent No. 5,764,731) discloses enhanced system for transferring, storing, and using signaling information in a switched telephone network.

Chida (US Patent No. 5,903,734) discloses multimedia information communication apparatus which stores received information in an encoded state.

Sonesh et al (US Patent No. 6,046,762) discloses multimedia telecommunication automatic call distribution system.

Gerszberg et al (US Pub No. 2002/0012353) discloses ISD controlled set-top box.

Barzebar et al (US Pub No. 2002/0044199) discloses integrated remote control and phone.

Chida et al (US Patent No. 5,524,194) discloses a data communication apparatus.

Szlam (US Pub No. 2002/0181398) discloses a method of remotely access, emulate, and control office equipments.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh-Vu H Ly whose telephone number is 703-306-5675. The examiner can normally be reached on Monday-Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 703-305-4744. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Art Unit: 2662

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

avl

June 2, 2003



HASSAN KIZOU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600